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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 880.084	06 14 2001	John Mamana	06920001AA	3811

7590 05 27 2003
McGuire Woods, LLP
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EXAMINER	
PATTEN, PATRICIA A	
ART UNIT	PAPER NUMBER

1654

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,084

Applicant(s)

Mamana, J.

Examiner

Patricia Patten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 10, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 24, and 25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 24, and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) Notice of References Cited (PTO-892) | 4) Interview Summary (PTO-413) Paper No(s) |
| 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) Notice of Informal Patent Application (PTO-152) |
| 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) | 6) Other: |

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DETAILED ACTION

Claims 1-13 and 24-25 are pending in the application and were presented for examination on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

Claims 1-13 remain rejected and new claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorsek (US 6,383,482 B1) in view of Eisenberg (1998). New claims 24 and 25 differ from claims 1-13 in that the claims do not recite green tea.

Applicant's arguments were fully considered but not found persuasive.


Applicant argues that "The deficiencies of Gorsek are not cured by Eisenburg" and contend that Eisenburg taught away from the claimed invention in that HMB was taught as being used for gaining weight, and not as an appetite suppressant (p.8-Arguments). Applicant points out that Eisenburg taught that one person taking HMB

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gained 15 pounds in two weeks and five days, and that Eisenburg stated that people are moving away from appetite suppressors and toward supplements such as HMB (p.8-Arguments).

Although Eisenburg taught that a person taking HMB gained weight, it is clear from the article that the weight gained was muscle weight: "...both pyruvate and HMB are purported to facilitate the reduction of body fat while increasing lean body mass" (col.1, Eisenburg).

One of ordinary skill in the art would have recognized that HMB was used for fat loss and muscle gain taking Eisenburg into account. Although Eisenburg taught that people might have been 'moving away' from taking appetite reducers, while moving toward HMB is not deemed to be a 'teaching away' from the Instantly claimed invention. The ingredients in the claims as disclosed by Gorsek were all known in the art for fat-loss. The mechanism for each ingredient was explained by Gorsek, not all being appetite reducers. For example, as pointed out in the previous Office action, Gorsek taught that the polyphenols of green tea as well as chromium picolinate helped increased fat metabolism (col.2, lines 11-13) while 5-hydroxytryptophan gave a feeling of satiety (col.2, lines 5-7). Therefore, it was known in the art that fat metabolizers and appetite reducers were advantageously combined in a single weight loss formulation.



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Therefore, the addition of HMB, a known fat reducer, to a composition comprising fat reducers and appetite suppressor(s) would have been obvious to one of ordinary skill in the art with the references before him/her. The ordinary artisan would have had a good expectation that the combination of HMB, a fat-metabolizer, to a product intended for weight loss which comprised green tea extract, chromium picolinate and 5-hydroxytryptophan, would have created a product with added fat-metabolizing activity.

A rejection under 35 U.S.C. § 103 based upon the combination of references is not deficient solely because the references are combined based upon a reason or technical consideration which is different from that which resulted in the claimed invention. Ex parte Raychem Corp., 17 U.S.P.Q. 2d 1417.

Again, because all of the claimed ingredients were known in the art for combating weight loss, variation of the quantity of each individual ingredient would have been optimization of result effective variables, routine in the art of pharmacology. Further, the inclusion of green tea would have been obvious to one of ordinary skill in the art because it was known, and disclosed by Gorsek that green tea contained fat-burning polyphenols.

No Claims are allowed.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Patricia Patten, whose telephone number is (703)308-1189. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Brenda Brumback is on 703-306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


CHRISTOPHER R. TATE
PRIMARY EXAMINER